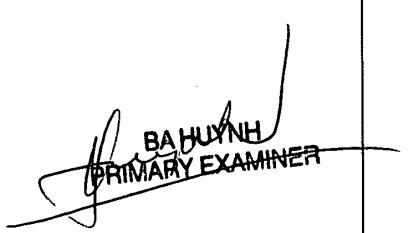| APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/074,544	05/08/98	MEYER	G	P2248-472

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BURNS DOANE SWECKER &  MATHIS L L P
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ALEXANDRIA VA 22313-1404
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EXAMINER
HUYNH, B

ART UNIT	PAPER NUMBER
2173	8

DATE MAILED: 11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Sep 21, 2000_

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under _Ex parte Quayle_ 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ 3 ___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) _1-61_ _____ is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-61_ _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BA HUYNH
PRIMARY EXAMINER

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. The amendments filed on 9/21/00 have been entered into the record. Claims 1-61 are pending in the application.

Claim Rejections - 35 USC § 112

2.   Claim 60-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- As for claim 60, lines 6-7: The phrase "determining... fails to exist <u>or</u> be up-to-date" contradicts to lines 3-5 of the claim, wherein an "and" condition is required (i.e., exist and up-to-date).

Claim Rejections - 35 USC § 102

3.   Claims 6-15, 29-38, 46-56 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #6,055,544 (DeRose et al). Rationales for the rejection continue to be as set forth in par. 3 of the last Office action.

- As for new claim 57: Claim 57 recites the similar elements of claim 6, thus is rejected for the same reason as set forth in the rejection of claim 6. A formatted table of content is displayed in figure 9.

- As for claim 58: It is implicitly included that DeRose's help manuals (col. 8, lines 15-20) are stored in a folder.

- As for claim 59: Claim 59 recites the similar elements of claim 15, thus is rejected for the same reason as set forth in the rejection of claim 15.

Claim Rejections - 35 USC § 103

4.   Claims 1-5, 16-28, 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #6,055,544. Rationales for the rejection continue to be as set forth in par. 5 of the last Office action.

- As for claim 60: DeRose et al fail to clearly teach the step determining if the table of contents needs to be generated if the table of content fails to exist or not up-to-date. However it would have been obvious to one of ordinary skill in the art, at the time the invention was made, implement the determining if the table of contents needs to be generated if not already exist or up-to-date. Motivation of the implementation is for generating an up-to-date table of content.

- As for claim 61: Determination of an up-to-date condition based on modification date would have been in common sense and obvious to one of skill in the art.

Response to Arguments

5.   Applicant's arguments filed on 9/21/00 have been fully considered but they are not

persuasive.

REMARKS:

As for claims 6-15, 29-38, and 46-56: DeRose et al teach a computer system for

retrieving of WWW interconnected documents (col. 1, lines 44-48). A plurality of related HTML

documents and associated files are published on WWW at a Web site (col. 2, lines 34-38). It is

inherently included in DeRose's teaching of "Web site" that a home page is provided at the site

which functions as a table of contents for the site (see attached dictionary's definition for "Web

site"). Thus DeRose's "Web site" comprises a plurality of related HTML documents listed in a

table of contents. The documents can be large documents (col. 3, lines 51-55) or small

documents (col. 4, line 11). Large documents can be books or operation manuals (col. 8,

lines 15-18). For each document, specially for each large document, a second table of contents

for the document is generated (col. 17, lines 62-66) to help downloading a specific portion of the

document instead of the entire document to reduce processing time (col. 4, lines 34-39). An

example (col. 18, lines 22-24) of the generating of the table of content for a document is given by

DeRose (see abstract). The applicants appear to take the example given by DeRose as the entire

DeRose's invention and argue that DeRose's invention deals with a single document only. This is

not true when the patent is considered as a whole, as outlined above.

The applicants further argue that DeRose fails to teach the generating a table of contents

of a computerized help system comprises of numerous individual files. In contrast to the

argument, DeRose teach the retrieving of numerous individual files (documents) through WWW,

as set forth above. The files can be of a help system (col. 8, lines 15-18). For each file, specially

for each large file, a table of content of the file is generated (col. 17, lines 62-66) to help

downloading a specific portion of the file instead of the entire file, thus processing waste can be

avoided (col. 4, lines 34-39; col. 11, lines 48-53).

The applicants argue that DeRose does not teach the step of "indexing each file and a first

level of each book of a predetermined folder for files of a first type". As set forth above, each

Web site comprises a table of contents (index) of related HTML documents, thus the indexing of

each file and a first level of each book (documents) for files of a first type (related files or

documents) is inherently included in DeRose teaching of "Web site". Each of the files is further

scanned for HTML meta-tags for adding data to a table of contents which lists elements of the

individual file (col. 11, lines 48-53; col. 15, line 1 - col. 19, line 35). Each element, by analogous

to the file, is further scanned for the element's table of contents (col. 13, lines 18-24).

In response to the argument that the operation manual is not a help file, the manual

provides guidance to the operations of systems, thus is a help file. See figures 9-11.

In response to the argument that DeRose does not teach a "creator designation" which

defines a file's type or class, the applicant appears to read limitations from the specification into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims

must be given broadest reasonable interpretation. The limitation "creator designation", by itself, can not be interpreted as having the function of defining a file's type or class because its function of defining the file's type or class is not recited in the claim. Thus DeRose's teaching of the content appended to the document (col. 15, lines 23-25) read on the claimed "creator designation".

In response to the argument that DeRose does not teach the use of HTML template for generating the table of contents, the HTML template used for generating the table of contents is disclosed by DeRose in col. 19, lines 4-22 and in figure 9, #160.

In response to the argument that DeRose does not implicitly include that the providing a "table of contents for each book in response to a request", the table of content is provided in response to the user selection of the book which send a signal (implicitly included) requesting the displaying of the table of content.

In response to the argument that DeRose does not teach the generated "table of contents comprises at least one link to a location of **a file**", each item in the table of content links to a target document (col. 2, lines 34-40; figures 9-11; col. 19, lines 16-18, 46-49). The target document can be a fragment (small file) of a document.

A table of content is generated and displayed based upon user input (col. 11, lines 45-53; col. 18, lines 57-59). A table of contents is generated if it is determined that the size of a document is too large (col. 13, lines 18-21).

As for claims 55-56, in response to the argument that DeRose does not teach the template for creating the table of contents, the template is disclosed by DeRose in col. 19, lines 4-22 and in figure 9, #160. The table of contents is created based on the template thus the determining whether the template exist is implicitly included in DeRose.

As for claims 1-5,16-28, and 39-45: The applicants repeat the argument that DeRose's invention does not apply for numerous files, this argument have been fully addressed as set forth above. DeRose' table of contents is generated dynamically (col. 22, lines 3-7). DeRose fails to clearly teach that the dynamically generated table is an updated table. However, in an analogous field of parsing an HTML document for creating a table of contents, Walls teach the creating of an up-to-date table of content. It would have been obvious to one of ordinary skill in the art, to combine Walls' teaching of creating the up-to-date table of content to DeRose. Motivation is for providing an updated table of content. For the argument that an Walls' index is not a table of content, Walls' index is a table of headers in a set of files (col. 4, lines 31-36) displayed to the user in a graphical representation of a directory or tree of file system (col. 11, lines 45-48), thus is a table of contents.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Inquires

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached on (703) 305-3821.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the
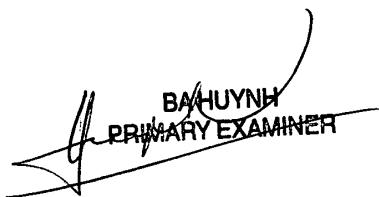
Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba
Primary Examiner
Art Unit 2173
11/2/00

BA HUYNH
PRIMARY EXAMINER